

II. Rejections under 35 U.S.C. § 102

The Examiner maintains the rejection of claims 1-10 and 12-25 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,635,240 to Bolich et al. ("Bolich"), and claims 1-25 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 20010003584 to Birkel et al. ("Birkel"). Applicants respectfully traverse these rejections for reasons of record and for the following additional reasons.

a) Rejection under 35 U.S.C. § 102(e) over Bolich et al.

A rejection under § 102 is proper only when the claimed subject matter is *identically described or disclosed* in the prior art. *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972). In the present case, Bolich, according to the Examiner, discloses aerosol hair styling compositions comprising specified amounts of a water soluble polyalkylene glycol (polyol), a liquid carrier, and a propellant. Final Office Action at 3. Also, the Examiner alleges that Bolich discloses an optional additional styling agent, such as an anionic polysaccharide, and an optional gelling agent that helps provide for improved hair hold and can be, for example, an anionic crosslinked carboxylic acid polymer such as CARBOPOL 934. *Id.* at 3-4. Applicants respectfully submit that Bolich has not identically described the presently claimed cosmetic composition, which comprises specified amounts of at least one anionic fixing polymer, at least one polyol with a molecular weight less than 500, an aqueous or aqueous-alcoholic medium, and at least one propellant gas as recited in the present claims.

To support the position that the claims are anticipated, the Examiner states that the "criteria for anticipation is that if one can immediately envisage the embodiment, then it is anticipated." Final Office Action at 6. Applicants respectfully contend that

while this language from M.P.E.P. § 2131.02 is appropriate in the context of generic chemical formulas anticipating a claimed species, it is being improperly extrapolated in this case by the Examiner to cover choices of several different ingredients within a composition. "One may look to the preferred embodiments to determine which compounds can be anticipated." M.P.E.P. § 2131.02. However, the class of compounds within the reference should be limited in order to anticipate. *In re Petering*, 301 F.2d 676, 682 (C.C.P.A. 1962). The ruling in *Petering*, relating to a compound, should not extend to a composition with four different ingredients. There is no reason why one of ordinary skill in the art, looking at Bolich, "would immediately envisage" a cosmetic aerosol composition for hair, packaged in an aerosol device, comprising: a) at least one anionic fixing polymer present in an amount ranging from 0.5% to 10% by weight, based on the total weight of the aerosol composition, b) at least one polyol with a molecular weight less than 500, present in an amount greater than 15% by weight, based on the total weight of the aerosol composition, c) an aqueous-alcoholic or aqueous medium comprising at least 10% by weight of water, based on the total weight of the aerosol composition, and d) at least one propellant gas in an amount greater than or equal to 30% by weight, based on the total weight of the aerosol composition.

Further, the Examiner states that with respect to Bolich's disclosure of the polysaccharides, "the species are sufficiently limited for one to immediately envisage the use of each polysaccharide respectively." Final Office Action at 7. Applicants respectfully disagree. As noted above, Bolich's compositions which require a polyalkylene glycol, a liquid carrier, and a propellant, "may further comprise one or more optional styling polymers . . . ," which include polysaccharide polymers that may be

anionic. Bolich at col. 6, ll. 47-49, col. 6, l. 67-col. 7, l. 3. Bolich provides no examples of compositions comprising anionic polysaccharide polymers and the list of polysaccharide styling polymers in column 6, line 65 - column 7, line 67 contains such a large number of species, that it is difficult to see how, even if the rationale of *Petering* applied, this list is *limited* enough for one to immediately envisage the use of anionic polysaccharides.

As an alternative to the disclosure of the anionic polysaccharide as corresponding to the presently claimed anionic fixing polymer, the Examiner points to the gelling agent, CARBOPOL 934, a cross-linked carboxylic acid polymer in examples XV and XVI of Bolich; these examples also contain a polyol, a propellant gas, and an aqueous medium. Final Office Action at 8. Resorting to an optional gelling agent to take the place of the anionic fixing polymer is improper 'piecing together', not anticipation, and certainly is no better than the attempt to correlate the anionic polysaccharide with the presently claimed anionic fixing polymer.

In addition, with respect to CARBOPOL 934, Applicant respectfully points out that the amount of CARBOPOL 934 disclosed in Examples XV and XVI is 0.3% and 0.15% by weight, respectively, whereas claim 1 of the present invention calls for the "at least one anionic fixing polymer present in an amount ranging from 0.5% to 10% by weight, based on the total weight of the aerosol composition." Thus, for this additional reason, Bolich fails to teach or even suggest a composition containing all of the presently claimed elements within the claimed range.

Therefore, Applicants respectfully submit that the criteria for anticipation have not been met. The § 102(e) rejection should accordingly be withdrawn.

b) Rejection under 35 U.S.C. § 102(b) over Birkel et al.

As discussed for Bolich above, Birkel has not identically described the presently claimed cosmetic composition, nor does Birkel provide direction to one of ordinary skill in the art to combine the presently claimed ingredients as recited in, for example, claim 1. Also as with Bolich, the Examiner appears to have selectively chosen aspects of Birkel and fashioned a grouping to read on the present invention. One of ordinary skill in the art would have to choose to add a co-solvent and then select among branched or unbranched hydrocarbons, which Birkel characterizes as "especially suitable" as co-solvents, or ethylene glycol, glycerol, or propylene glycol, which are "especially preferred" as water-soluble solvents. Birkel at [0027]. Birkel provides no guidance for selecting which optional co-solvent or solvent, if any, the artisan should choose and not one of the 10 examples in Birkel shows the use of any of these solvents or co-solvents.

Birkel further discloses that the hair composition can exist in various application forms, such as a lotion, non aerosol spray, aerosol spray (sprayed by means of a propellant), aerosol foam, non-aerosol foam, cream, wax, gel, liquid gel, sprayable gel or foaming gel. Examiner points to example 2 as disclosing a hair spray comprising a propellant and filled in an aerosol can. Office Action at 13. In examples 2, 3, and 4, the 100 grams of the "effective ingredient containing solution" containing 10.00 grams of water is diluted when it is filled in an aerosol can in a ratio of 45:55 with DME as propellant. The result is a composition that is 4.5 % by weight of water, based on the total weight of the aerosol composition. This fails to meet the limitation in claim 1 of the present invention, "comprising at least 10% by weight of water, based on the total weight of the aerosol composition." Therefore, while Birkel provides guidance for an

aerosol composition, it fails to teach or even suggest a composition containing all of the presently claimed elements within the claimed range.

Therefore, Applicants respectfully submit that the criteria for anticipation have not been met. The § 102(b) rejection should accordingly be withdrawn.

IV. Double Patenting Rejections

a) Copending Application Nos. 10/796,016, 11/124,229, and 11/220,586

Applicants respectfully request that the nonstatutory obviousness-type double patenting rejections over

(1) claims 1-29 of copending Application No. 10/796,016 alone;

(2) claims 1-29 of copending Application No. 10/796,016 in combination with U.S. Patent No. 5,639,448;

(3) claims 1-25 of copending Application No. 11/124,229 in combination with U.S. Patent No. 5,639,448; and

(4) claims 1-20 of 11/220,586 in combination with U.S. Patent No. 5,639,448, be held in abeyance until allowable subject matter is indicated in the present application. See M.P.E.P § 804 I.B.

b) Claims 23-50 of copending Application No. 10/279,036 in view of U.S.

Patent No. 5,639,448

The Examiner maintains the provisional rejection of claims 1-25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23-50 of copending Application No. 10/279,036 ("the '036 application") in view of U.S. Patent No. 5,639,448 ("US '448"). Final Office Action at 20. Applicants respectfully traverse this rejections for reasons of record and for the following additional reasons.

Despite his assertions on page 22-23 of the Final Office Action, Applicant maintains that the Examiner has provided no evidence of motivation to combine US '448 with the claims of the '036 application. US '448 merely states that other cosmetic additives can be incorporated in its claimed composition. US '448 at col. 13, ll. 56-59. One possible additive is an organic solvent, which can be added to solubilize compounds that are not sufficiently soluble in water. *Id.* at col. 13, ll. 64-67. Among these additives, polyols are "suitable solvents" for the composition that "can be present in an amount from about 1% to about 75%." *Id.* at col. 14, ll. 3-10. The Examiner states that polyol solvents are *conventionally* utilized in hair compositions as carriers and solvents. Office Action at 21. However, such indication that polyols may be required for the solubility of particular compounds is not tantamount to conventional use, especially when there is no suggestion in the '036 application that solubility of any particular compounds is a concern.

Also, Applicants maintain, for reasons of record, that the Examiner's citation of *In re Aller* is inappropriate. The Examiner fails to explain how the conclusions of *In re Aller*, which were made in reference to a chemical process with defined ingredients, can be extended to the choice of ingredients, as well as the concentration of ingredients, for a composition as presently claimed. Moreover, the Examiner has provided no evidence that modification of the '036 claims by the addition of a polyol in the claimed amount would result from the "routine efforts of the artisan." There is simply no sufficient suggestion or motivation to combine.

For at least these reasons, Applicants respectfully submit that the '036 application claims and present claims are not obvious modifications of one another. Therefore, the rejection should be withdrawn.

c. Claims 20-36 of copending Application No. 10/479,170 in view of U.S. Patent No. 5,639,448

The Examiner maintains the provisional rejection of claims 1-25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-36 of copending Application No. 10/479,170 ("the '170 application") in view of US '448 . Office Action at 25. Applicants respectfully traverse this rejections for reasons of record and for the reasons stated above.

Applicants submit that the '448 patent provides no motivation to one of ordinary skill in the art to use a polyol in the presently claimed amount in the claims copending in the '170 application. Accordingly, Applicants request withdrawal of the rejection.

CONCLUSION

In view of the above arguments and amendments, Applicants submit that the present claims are in condition for allowance. Prompt action by the Examiner is respectfully requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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